

REMARKS

This Reply is in response to the Final Office Action mailed on September 20, 2005 in which Claims 1-3, 5-31, 45-46, 48-50 and 52-56 were allowed and in which Claims 32, 33, 35-43 and 57-58 were rejected. For the reasons which follow, Applicants respectfully request that the rejections of the claims be withdrawn.

I. Examiner Interviews Summary.

On December 1, 2005 and December 19, 2005, telephonic interviews were held between Examiner Grant and Applicants' attorney, Todd A. Rathe. During such interviews, it was clarified that Claims 45-46, 48-50 and 52-56 were also allowed. During such interviews, the finality of the present Office Action was discussed. It was agreed upon that the finality of the Office Action mailed on September 20, 2005 would be withdrawn since now rejected Claims 57 and 58 constituted previously objected to Claims 17 and 36, respectively. Lastly, the rejection of Claims 32, 33 and 35-43 under 35 U.S.C. § 101 was discussed. No agreement was reached with respect to the rejection of such claims under 35 U.S.C. § 101.

Applicants wish to Examiner Grant for the opportunity to discuss the rejections.

II. Rejection of Claims 32-43 and 58 Under 35 U.S.C. § 101.

Paragraph 1 of the Office Action rejected Claims 32-43 and 58 under 35 U.S.C. § 101 as lacking patentable utility. During the Examiner interview held on December 1, 2005, Examiner Grant clarified the basis of the rejection. In particular, Examiner Grant indicated that Claims 32-43 and 58 were rejected under 35 U.S.C. § 101 because the purpose for the recited method was not set forth in the preamble itself. Applicants traverse this rejection and request that this rejection be withdrawn for the following reasons.

Independent Claims 32 and 58 recite a method which includes generating a scanned image preview from image data corresponding to an image, defining the image region of the scanned image preview to retain and emulating a final scan of

the image region to generate a final scanned image. Thus, the utility of the method recited in such claims is clear: generating a final scanned image through emulation.

As noted above, the Office Action asserts that such claims lack utility simply because the claims do not recite the function in the preamble. However, nowhere is it required that a preamble of a claim recite anything more than the category of invention, i.e., apparatus, method of making, method of using, or composition. In support of its position, the Office Action refers to 35 U.S.C. § 100(b) and 37 CFR § 1.75(e)(1). However, neither 35 U.S.C. § 100(b) nor 37 CFR § 1.75(e)(1) support a requirement that the preamble recite the utility of a claim. In contrast, 35 U.S.C. § 100(b) merely states:

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

37 CFR § 1.75(e)(1) merely recites that:

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

(1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known.

(Emphasis added.)

As emphasized above, 37 CFR § 1.75(e)(1) is merely a suggested form of the claim, not a requirement. In particular, 37 CFR § 1.75(e)(1) says that any independent claim "should", not "must" or "shall", contain a preamble comprising a general description of all the elements or steps of the claim combination which are conventional or known. The fact that 37 CFR § 1.75(e)(1) is merely a suggested claim format rather than a required claim format is evidenced by the corresponding fact that not all claims include a preamble which recite a description of what is conventional or known. The only such claims that have a preamble that recite a description of what is conventional or known are commonly referred to Jepson

claims. Other non-Jepson claims lack such a preamble. Applicants are not aware of any case law interpreting 35 U.S.C. § 100(b) or 37 CFR § 1.75(e)(1) as requiring a preamble to recite the utility of a claim.

Moreover, case law is replete with instances where the preamble has been used to limit the scope of protection afforded by the claim. To artificially require Applicants to recite a utility in the preamble would leave Applicants vulnerable to similar potentially unduly limiting claim constructions. Accordingly, Applicants request that the rejection of Claims 32-43 and 58 under 35 U.S.C. § 101 be withdrawn.

III. Rejection of Claims 57 and 58 Under 35 U.S.C. § 102(e) Based Upon Kumpf.

Paragraph 3 of the Office Action rejected Claims 57 and 58 under 35 U.S.C. § 102(e) as being anticipated by Kumpf, U.S. Patent No. 6,289,371. For the reasons which follow, Applicants respectfully request that the rejection of Claims 57 and 58 based upon Kumpf be withdrawn.

A. Claim 57.

Claim 57 recites an imaging system which includes a component configured to generate a scanned image preview from image data corresponding to an image, an image region selection control configured for manipulation to select an image region of the scanned image preview to retain and an image region definition control configured for manipulation to define a classification of the image region, wherein the component is further configured to emulate a final scan of the image region to generate a final scanned image.

Kumpf fails to disclose an imaging system in which a region or portion of a scanned image preview is selectively chosen and retained, in which the selected region is classified and in which a final scan of the region is emulated. In contrast, Kumpf merely discloses carrying out a preview scan (see col. 7, lines 1-13), selecting a portion of the preview image (col. 7, lines 18-19), and subsequently

carrying out a second final scan (see col. 7, lines 41-44). Nowhere does Kumpf disclose or suggest defining a classification of a selected image region or portion of a preview image. Moreover, nowhere does Kumpf disclose or suggest emulating a final scan of the selected region or portion of the preview scan to generate a final scanned image. Once again, Kumpf specifically requires two distinct scans: (1) a first preview scan and (2) a second final scan. Accordingly, the rejection of Claim 57 based upon Kumpf is improper and should be withdrawn.

B. Claim 58.

Claim 58 recites a method which includes generating a scanned image preview from image data corresponding to an image, defining an image region of the scanned image preview to retain and emulating a final scan of the image region to generate a final scanned image, wherein emulating includes interpolating the image data to improve a resolution of the image region.

Kumpf fails to disclose or suggest emulating a final scan of an image region from a scanned image preview, wherein emulating includes interpolating the image data from the preview scan to improve a resolution of the image region. In contrast, Kumpf generates a final scanned image by carrying out a second final scan distinct from the first preview scan. Nowhere does Kumpf disclose or suggest interpolating data from a preview scan to generate and emulate a final scan.

The fact that Kumpf fails to disclose emulating a final scan by interpolating image data to improve resolution of the image region is impliedly acknowledged in the Office Action because (1) the Office Action fails to point to a single citation or portion of Kumpf which describes interpolating image data from a preview scan to emulate a final scan, and (2) the already indicated allowability of Claims 46 and 50. Those portions of Kumpf cited in the Office Action (col. 7, lines 14-22; col. 8, lines 48-54 and 62-66; and col. 7, lines 1-5) fail to disclose emulating a final scan by interpolating image data from a scanned image preview. Accordingly, the rejection of Claim 58 based upon Kumpf is improper and should be withdrawn.

IV. Conclusion.

After amending the claims as set forth above, claims 1-3, 5-33, 35-43, 45-50 and 52-58 are now pending in this application.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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